

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of |) | Art Unit: 2192 |
| |) | |
| Inventor(s): Emmelmann |) | Examiner: Kendall |
| |) | |
| Application No.: 09/449,021 |) | |
| |) | |
| Filed: November 24, 1999 |) | |
| |) | |
| Title: INTERACTIVE SERVER SIDE COMPONENTS |) | REQUEST FOR PRE-APPEAL REVIEW |

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

I. INTRODUCTION

Applicant requests a pre-appeal review on the basis that the rejections of record are improper, and this brief discusses the factual errors and deficiencies in the rejections. For example, many of applicant's claims require editing a web application that is running while being edited, and other claims require web-based editing of executable components on the server that contain instructions to generate code. These features are not taught or suggested in the cited art under any reading, but are plainly recited in the claims. In addition, the examiner did not take into account important amendments to claim 6. Further, after applicant submitted an Appeal Brief, the Examiner reopened prosecution and cited a new reference, Nazem, that is no more relevant than the art already of record.

II. OVERVIEW OF APPLICANT'S INVENTION

Applicant has invented a web-based software development system for dynamic web applications that dynamically generate documents on a web server for display by a web browser running on a client computer. The system allows a user to create applications by combining web components on document templates. The components are implemented as classes programmed in an object-oriented programming language and are executed during page generation on the server. Components can also be interactive, i.e., on a first browser request they are displayed, and on subsequent browser requests they can react on user input by executing instructions on the server, for example, to place items into a shopping basket or to store data into a database.

Applicant's software development system includes a browser based editor. Advantageously, applicant's system allows the user to run an application during editing. Thus, the developer can test and run the application as well as modify the application inside the web browser at the same time. During editing, the generated application pages look similar to the pages generated by the end user's application, but they contain additional handles that mark components on the pages. The user can click on these handles in order to edit the component and thereby modify the source code of the application.

Internally, applicant's system includes a page generator and components. They can run an application in a special editing mode wherein in addition to normal execution, editing features are inserted into the generated pages. Via these editing features, the editor modifies the application source code while the user works on a generated application page displayed inside the browser.

For a longer and more detailed overview see the Appeal Brief on pages 1-3.

III. THE CITED PRIOR ART

The examiner has relied upon three patents in making his rejection. However, the Examiner has propagated factual inaccuracies regarding what is actually disclosed in these references. Even more egregiously, the examiner rejected claims 51, 59 and 74 with reference to the reasoning for claim 6, but failed to consider a crucial amendment to claim 6. (*See* Section VI below).

Truong discloses a web-based text editor that does not run the files edited, but just shows the source code of a script or HTML page as text for editing. (*See* Fig. 5 and Col. 10:45-50; Appeal Brief at 4). D'Arlach does not edit applications, but edits web page templates stored as elements in a database. These templates correspond to static web pages, and page generation takes place during publishing, not dynamically at run-time of the application (Col. 5:30-33; Appeal brief at 5). Finally, Nazem shows a configurable news web application that provides a tool for editing user preferences (Col. 6:13) in the form of a user configuration record (Fig. 2, item 206). It does not edit the application source code itself, nor does it allow new applications to be developed. The user can only select among preexisting features of the application. In addition, editing does not take place while the application is running inside the browser, but instead, after editing, the application is restarted. (Col. 6:15-17). Thus, none of the cited references makes any express or implicit disclosure that would teach or suggest running an application while editing it, and the Examiner has already acknowledged that such a feature would be distinct. (*see* Advisory Action at Continuation Sheet).

IV. CLAIM LANGUAGE

Applicant's editor edits a dynamic web application stored in the form of page templates on a server. Advantageously, it allows the developer to work on generated pages that, except for the editing features, look and function similar to the generated pages displayed by the application outside the editor.

The application actually runs during the editing process and generates pages for display to the developer. This allows the developer to work on a functional application during editing. In contrast, Truong merely displays the source code during editing. (See Fig. 5). D'Arlach does not edit applications, but edits templates that correspond to static web pages. (Col. 5:30-33; Appeal Brief at 5). Nazem does not edit the application itself, but only preferences. (Col. 6:13). Nazem also does not run the application during editing but stops and restarts the application after editing is complete (Col. 6:16-18). These distinctions are clearly recited in applicant's pending claims:

Claim 1: *"a page generator running one of the applications being developed ... by generating the generated documents including additional editing features ...; an editor directly operating on the pages displayed by the browser via the editing features"* and *"allowing the user to work on a functional application during development;"* Claim 22: *"part of the second document appears and functions similar to the first document;"* Claim 59: *"generated documents from dynamic web documents which look and function similar to the end user's view of the documents, the editor program comprising first instructions for requesting the document generator to process a dynamic web document leading to a generated document"*, Claim 90: *"wherein scripts contained in said document remain functional during editing;"* Claim 125: *"A method for editing an application ... comprising the steps of ... running the application."*

Advantageously, applicant's editor handles executable components on page templates. Components are implemented as classes of an object-oriented programming language, and placing a component on a page template causes an appropriate object of the component class to be created and executed. By selecting a suitable order and nesting of the components, correct execution of the components can be determined. Applicant's editor has special functions to maintain the components on the web page templates, and thus allows the user to create applications. In contrast, Truong's editor only works on text files and has no specific functions for components. D'Arlach's editor works on "elements" that are non-executable data items. Nazem's editor edits application preferences. These distinctions are expressed using the following claim language:

Claim 22: *"an editor ... for inserting, deleting, and modifying components on document templates; ...executing components;"* Claim 51: *"components containing instructions to generate browser code ... maintaining components on document templates;"* Claim 74: *"components, that include instructions to generate browser code ... maintaining components on document templates;"* Claim 114: *"components for execution on the server ... including first features to cooperate with an editor."*

Applicant's components are interactive and so can actively interact with the user. However, Neither Truong nor D'Arlach show executable components. Nazem shows modules that display information for a news web site to the user, but they are not interactive. See claim 6: *"component that reacts interactively on user input by executing instructions contained in said component on the server"*.

Applicant's system is a software development system to create web applications. Truong shows a text editor without specific functions for software. D'Arlach is only for developing static page templates. Nazem is only intended for customizing an existing application by editing preferences, not for creating new applications. See the claim language "*a software development system*" as in claim 1, 6, 59 and 74, and "*an application to develop and maintain applications*" as in claim 22.

V. THE EXAMINERS REASONING

In the 7 years of prosecution history of this patent, the Examiner has cited various prior art patents, and for most of these, the Examiner ultimately changed his mind regarding the applicability of the reference. However, issues from the previous rejections have now come up again with the citation of the Nazem patent. For example, Nazem is not a software development system and does not appear to demonstrate editing an application while it is running. Thus, Nazem is no more relevant than other references of record. Furthermore, the Examiner's reasoning towards the independent claims 22, 26, 90, and 114 has not changed.

VI. DETAILED REASONING

With regard to claim 1, the Examiner apparently now agrees that Truong does not explicitly disclose *an editor capable of directly operating on the documents displayed by the browser*. (Action dated 6/15/06 at 6). Instead, he alleges that Nazem describes "a dynamic page generator ... in which editing process can be initiated." Nazem himself, however, explicitly writes that a "preference editing process can be initiated" (Col. 6:13). Preference editing is different from editing an application because it does not edit the source code of the application itself, but just a configuration record, and so editing is limited to changing preferences representable in the configuration record and already programmed into the application. Applicant submits that the examiner is mistaken in concluding that Nazem's preference editing process renders obvious applicant's claimed editor.

In addition, Nazem explicitly states that "once the editing process is complete, the user template is ... regenerated" (Col. 6:16-18). In contrast, applicant has claims that require the application to run during editing. (*See* section IV above). In addition, the examiner does not even state how Truong's text editor and Nazem's preference editor could possibly be combined to come up with applicant's claimed editor.

Claim 6 requires the server to contain at least one component that reacts interactively on user input by executing instructions "*contained in said component*" on the server. This limitation was added by amendment dated 7/31/03, and appears to have been ignored by the Examiner. The examiner cites HTML elements in Truong as meeting the claim limitations. However, these HTML elements are part of the browser, and not on the server, and do not contain any instructions for execution on the server. (*See*

Appeal Brief at 26-27).

With regard to claim 22, Truong does not show components for execution by a document generator and an editor for inserting, deleting and modifying such components on page templates. The Examiner does not cite any specific item in Truong that he considers equivalent to applicant's components, but just cites general discussions about inserting, deleting and modifying characters. (*See* Appeal Brief at 38-39).

Claim 26 explicitly requires that "a part of the second document appears and functions similar to the first document," which is not the case in Truong, since Truong only edits source code, and the source code of a web page looks quite different than the normal display. (*See* Appeal Brief at 35-36).

With regard to claim 51, 59 and 74, the examiner refers to his reasoning for claim 6, although claim 6 does not deal with editing or an editor, which is the subject of claims 51, 59 and 74.

Claim 90 requires that scripts stay functional during editing. Truong's editor just shows the source code of a script which is not running during editing (Fig. 5). (*See* Appeal Brief at 30-32). The Examiner refers to claim 1 in rejecting claim 90, although claim 1 and its reasoning does not deal with scripts. *Id.*

For claim 114, the examiner has not cited any prior art that shows components containing instructions on the server and also features to cooperate with an editor. (*See* Appeal Brief at 19-20).

For claim 125, the examiner again refers to the reasoning of claim 1, although such reasoning does not deal with components, which are required by claim 125.

VII. CONCLUSION

For all the foregoing reasons, applicant submits the rejections of record are clearly erroneous and should be withdrawn. The rejections are based on clear factual errors and deficiencies in the Examiner's application of the prior art, and in the Examiner's reading of applicant's claims.

Respectfully submitted,

Date: September 13, 2006

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) EMMEL-01000US0 | | | | | | | | | |
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| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 13, 2006</u> Signature _____ Typed or printed name <u>Richard A. Nebb</u> | Application Number <u>09/449,021</u> | Filed <u>November 24, 1999</u> | | | | | | | | | |
| | First Named Inventor <u>Emmelmann</u> | | | | | | | | | | |
| | Art Unit <u>2192</u> | Examiner <u>Kendall</u> | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u>/Richard A. Nebb/</u></td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td><u>Richard A. Nebb</u></td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,540</u></td><td><u>415-369-9660</u></td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td><u>September 13, 2006</u></td></tr></table> | | | | <input type="checkbox"/> applicant/inventor. | <u>/Richard A. Nebb/</u> | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | <u>Richard A. Nebb</u> | <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,540</u> | <u>415-369-9660</u> | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>September 13, 2006</u> |
| <input type="checkbox"/> applicant/inventor. | <u>/Richard A. Nebb/</u> | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | <u>Richard A. Nebb</u> | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,540</u> | <u>415-369-9660</u> | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>September 13, 2006</u> | | | | | | | | | | |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | | | | | | | | | |
| <input type="checkbox"/> *Total of _____ forms are submitted. | | | | | | | | | | | |

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